

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Attorney Docket No. 2007_0365
Tsuneo YASUMA et al.	:	Confirmation No. 1184
Serial No. 10/558,846	:	Group Art Unit 1625
Filed November 30, 2005	:	Examiner Nizal Chandrakumar
CONDENSED RING COMPOUND	:	Mail Stop: ISSUE FEE



REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment indicated on the Notice of Allowance under 37 CFR § 1.705(b).

The relevant dates as specified in §§ 1.703 (a)-(e) are as follows:

USPTO Delay

U.S. Serial No. 10/558,846 is a national phase filing of international patent application no. PCT/JP2004/007770, filed May 28, 2004, and all of the requirements of 35 U.S.C. § 371 were fulfilled on May 30, 2005. Applicants received a first Office Action on November 16, 2007, which was 290 days after May 30, 2005. Thus, the delay under 37 CFR § 1.703(a)(1) is **290 days**.

A non-final Office Action was issued on April 9, 2009, and a response to the Office Action was timely filed on July 9, 2009. A notice of allowance was mailed on November 16, 2009, which was 4 months and 7 days after the response was filed. Therefore, the USPTO delay under 37 CFR § 1.703(a)(2) is **7 days**.

Therefore, the total USPTO delay under 37 CFR § 1.703(a) to date is **297 days**.

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Applicant Delay

A non-final Office Action was issued on February 11, 2008, setting a shortened statutory period for response of Sunday, May 11, 2008. A response to the Office Action was filed in the USPTO on Monday, May 12, 2008. Because a response to the Office Action was filed on the first business day following the due date of May 11, 2008, the response was timely filed under MPEP § 710.05. Therefore, Applicant did not delay in responding to the Office Action issued February 11, 2008.

A final Office Action was issued August 1, 2008, setting a shortened statutory period of response of November 1, 2008. A Request for Continued Examination was filed February 2, 2009, which was 93 days later. This constitutes an Applicant delay under 37 CFR § 1.704(c) for failing to engage in reasonable efforts to conclude prosecution of the application. Thus, Applicants caused a delay under 37 CFR § 1.704(c) of **93 days**.

According to the USPTO PAIR website, the submission of the Information Disclosure Statement (IDS) filed on October 2, 2009 resulted in an Applicant delay of an additional 85 days. However, the IDS should not be considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR § 1.704(c)(8), because each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart foreign application and this communication was not received by any individual designated in § 1.56(c) more than 30 days prior to the filing of the IDS in accordance with 37 CFR § 1.704(d).

Each item of information cited in the IDS on October 2, 2009 was first cited in a Supplementary European Search Report issued August 21, 2009 in connection with corresponding European Application No. 04 74 5580, and this communication was received September 4, 2009 by Takashima P.O. A letter from the European Associate to Takashima P.O. showing the date of receipt of the European Search Report in Takashima P.O. is submitted herewith. Thus, each item of information contained in the IDS was not received more than 30 days prior to the filing of the IDS in the USPTO. Therefore, the filing of the IDS does not constitute a failure to engage in reasonable efforts to conclude prosecution of the application under paragraph 37 CFR § 1.704(c)(8).

Thus, the total delay by Applicants under 37 CFR § 1.704(a) is **93 days**.

Correct Calculation of PTA

The total USPTO delay under 37 CFR § 1.703(a) to date is **297 days**. The total Applicant delay under 37 CFR § 1.704(a) is **93 days**. The total PTA is the number of days of USPTO delay minus the number days of Applicant delay, which is: **297 – 93 = 204 days**.

Accordingly, the PTA should be 204 days.

The present application is not subject to a terminal disclaimer.

The appropriate fee is enclosed.

Accordingly, Reconsideration of the Patent Term Adjustment is respectfully requested.

Respectfully submitted,

Tsuneo YASUMA et al.

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European Patent Application 04745580.3-2123
"CONDENSED RING COMPOUND"
Takeda Pharmaceutical Company Limited

Dear Mr. Takashima,

Please find enclosed the European Search Report, the cited references as well as information concerning patent families of the cited patent references.

The Search Report identifies 13 documents which are categorized "X" which designates prior art documents being of particular relevance with regard to novelty and inventive step of the claimed invention.

We will keep you informed about all further developments in this case.

Very truly yours,

Birgitt Ritter

Birgitt Ritter

(Assistant to Dr. Thomas Weber)

Encls.

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20 August 2009

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